

## **REMARKS**

### **I. CLAIMS 10, 12, AND 13 CORRESPOND TO THE ELECTED SPECIES**

The Office defines alleged Species IV as “wherein the surface layer includes upraised members”<sup>1</sup> (emphasis added). The Office admits on the record that claim 10 is directed to alleged Species IV.<sup>2</sup> Claim 12 recites “wherein the surface finish includes a combination of upraised members and depressed members.” Thus, claim 12 is directed to alleged Species IV because claim 12 requires that the surface finish “includes...upraised members....” Similarly, claim 13 recites “wherein the surface finish includes at least two of the following features:... (a) upraised bumps....” Therefore, claim 13 is directed to alleged Species IV because claim 13 requires that the surface finish “includes...upraised bumps....”

Accordingly, Applicant respectfully submits that claims 10, 12, and 13 correspond to elected, alleged Species IV.

### **II. THE REQUIREMENT TO ELECT SPECIES IS IMPROPER**

The Office predicates its allegation that the alleged Species I-IV do not relate to a single general inventive concept because “the species lack the same or corresponding special technical features for the following reasons: The examiner has listed the different technical features above for each species which are not included in the other species.”<sup>3</sup> Applicant respectfully traverses the Office’s allegation, as the claims directed to the alleged species are linked by independent

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<sup>1</sup> Detailed Action, p. 2, I. 10.

<sup>2</sup> Detailed Action, p. 3, I. 6.

claim 1. While claim 1 is rejected under 35 USC § 102(b), as being anticipated by either U.S. Patent 4,986,496 to Marentic *et al.* ("Marentic") or U.S. Patent 5,508,084 to Reeves *et al.* ("Reeves") in the Office Action of 25 July 2008, Applicant, in his Response dated 20 December 2008, rebuts this improper rejection. The Office, however, has not responded to Applicant's rebuttal. Thus, until the Office makes out a *prima facie* case of anticipation with regard to claim 1, Applicant maintains that independent claim 1 avoids the prior art. MPEP 1850 instructs that "[i]f the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims." For at least this reason, the requirement to elect species is improper and should be reconsidered and withdrawn.

It should also be noted that the Examiner in the present Application was also the Examiner of record in the corresponding PCT International Application. Neither the International Search Report nor the International Preliminary Examination Report indicates that unity of invention is lacking. For example, all of the pending claims (*i.e.*, claims 1-38) were examined by the Examiner in the present Application as an authorized officer of the International Preliminary Examination Authority without any requirement to pay search fees for additional inventions. It should further be noted that, according to PCT guidelines, the present Application was examined with respect to unity of invention both "*a priori*," that is, before considering the claims in relation to any prior art, and "*a posteriori*," that is, after taking the prior art into consideration, with no lack of unity of invention being found.

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<sup>3</sup> Detailed Action, p. 3, ll. 13-16.

The references cited in the International Preliminary Examination Report are the same references cited in the art rejections in the present Application. Thus, unity of invention was not found to be lacking by the present Examiner during international preliminary examination while considering the same references cited in the present Application. For at least this additional reason, the requirement to elect species should be reconsidered and withdrawn.

**III. CLAIMS 1-5, 9, AND 14-25 ARE GENERIC TO THE ALLEGED SPECIES**

The Office indicates that claims 1 and 20 are generic to the alleged species.<sup>4</sup> Applicant respectfully asserts that, in addition to claim 1 and 20, claims 2-5, 9, 14-19, and 21-25 are generic. Accordingly, using the Office's construction, Applicant respectfully submits that if any of claims 1-5, 9, and 14-25 are allowable, claims 6-8 and 11 must be rejoined for examination on the merits.

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<sup>4</sup> Detailed Action, p. 4, I. 8.

## **CONCLUSION**

Applicant elects alleged Species IV with traverse, in accordance with the applicable Rules of Practice and to advance the prosecution. However, the Requirement to Elect Species is improper. Accordingly, in traverse, Applicant requests withdrawal of the Requirement to Elect Species for the reasons set forth above. As Applicant has elected an alleged species in response to the Requirement to Elect Species and has identified the claim corresponding to the elected species, this response is complete. The Examiner is invited to contact the undersigned at (817) 578-8616 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date

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